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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/970,040	10/02/2001	Yasushi Takeda	100809-16276 (SCEY 19.027	8691
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26304 7590 08/29/2003

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,040

Applicant(s)

TAKEDA ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the language is not coterminous with that as required by an abstract. The language is not clear and concise and does not adequately describe the invention. Correction is required. See MPEP § 608.01(b).

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Drawings

The drawings are objected to because the language in the claims does not match the language in the drawings making it difficult to one of ordinary skill in the art to ascertain where the claimed features are actually illustrated in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid *abandonment* of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The constant and repeated usage of the word object with reference to only a numerical adjective renders the claim indefinite as it is not properly defined to one of ordinary skill in the art what these objects are and how they differ from each other.

Regarding claims 1, 14, 27, 40 and those dependent therefrom, it is unclear to one of ordinary skill in the art how the first object is related to the second object as the claim never states that the first object is actually generated, only that the second object is generated from the

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first object. There is no positive linkage between the two objects and it is unclear to one of ordinary skill in the art what is meant by object as there is only a numerical reference differentiating the two and one of ordinary skill in the art would not readily be able to ascertain that which is meant by first and second object.

Regarding claims 3, 16, 29 and those dependent therefrom, it would not be clear to one of ordinary skill in the art how the third object is associated with the first object and the means by which it is acquired. Further, the same would hold true for the fourth object in relation to the second object. It is not adequately supported how the fourth object will differ from the third object or the manner in which the objects can be different, since they are both objects. Nor is it clear how they differentiate from the said first and second objects. The claim is also indefinite in that the punctuation and grammar are replete with errors making the intentions of the limitation not easily ascertainable.

Regarding claims 4, 17, and 30, it would not be understood by one of ordinary skill in the art how the second object would be changed based upon the addition of a fourth object as neither are clearly defined and the relationship between the two is not clear.

Regarding claims 5, 18, and 31, one of ordinary skill in the art would not understand what is encompassed by the limitations of this claim as the predetermined shape is not defined, nor is it disclosed how the predetermined shape is obtained. Therefore, manners in which other shapes which have also not been properly defined, are compared to the predetermined shapes can not be ascertained by one of ordinary skill in the art as well as the relationship that causes an event when the flag to be turned on.

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Regarding claims 7, 20, and 33, the claim is indefinite in that it is contradictory to the parent claim. The parent claim states that the object is generated and is thus contradictory to the limitation stating that there is a decision involved as to whether the second object is generated. Further, there is no adequate support to ascertain what is meant by a circumferential environment condition as a deciding means.

Claims 10, 23, and 36, recite the limitation "controlling at least one of the shape and the motion of the second object" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. There is no support for this functionality in the disclosure of the parent claim.

Claims 12, 25, and 38 are indefinite in that one would not understand what is meant by self-motivatedly as it is not an art accepted term and the intended meaning would not be understood by one of ordinary skill in the art.

For examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The object control process program to be executed by a computer

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is not tangibly stored; therefore, its operation is not statutory as is it not tangibly embodied within the computer structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horigami et al. (US Patent No. 6,585,599).

Horigami et al. teach of an object control method comprising the steps of generating a second object (FIG 2, reference 112) that represents a shadow of a first object (FIG 2, reference 111) in virtual space (FIG 2). The second object character works with the ally character, thus becoming a shadow fighting object to the first character and is controlled independently of the first object (Column 5, lines 1-10) and any other sources yet is still present with the first object. The control of the second object does not depend on any other sources, including the first

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character, or any other parameters associated with the game. Therefore, any light source used in the game to illuminate the battle between the characters would not have an effect on the second shadow object. Regarding claim 14, the object control method can be stored on a computer readable storage medium (Column 8, lines 50-67). Regarding claim 27, a program execution device is inherently used to execute the object control process program. Regarding claim 40, a program to control the method is also inherent to the system disclosed by Horigami et al.

Regarding claims 2, 15 and 28, the motion of the second object is controlled independently of the first object (Column 5, lines 1-10).

Regarding claim 3, 16 and 29, Horigami et al. disclose the process of generating a character includes assigning objects to the characters (FIG 4). Thus when the characters use these objects in attack, their shape is changed to represent the use of the object (FIG 6). Horigami et al. disclose that the player and the shadow can have common actions (FIG 4). Horigami et al. disclose that other object contents can be different from character to character. However, it would be obvious to one of ordinary skill in the art based upon the disclosure that the attack and defense values are shared by the characters, to also include other objects that are shared by the characters to present a more unified battlefield. Thus, if the first character would receive an object, the second character would also receive this object as they represent a unified fighting team. One of ordinary skill in the art would be motivated to make this incorporation because one of ordinary skill in the art would recognize that through the character building process as disclosed by Horigami et al., it would be obvious to allow characters fighting for the same cause to be allocated similar object weapons to provide a joined team. By doing this, the player would feel more confident with his/her character(s) as they would be more familiar with

the objects associated with and thus feel a higher level of comfort and ease, thus enhancing enjoyment.

Regarding claim 4, 17 and 30, as disclosed above, the shape of the character changes with the addition of objects (FIG 2). Thus, it would be obvious to one of ordinary skill in the art that if the second character were to receive an object as the first character did, as disclosed above, the second character would change shape to represent the carrying of the current object.

Regarding claim 5, 18 and 31, when the shape obtained by adding the object to the first character is predetermined to be of a certain shape, representing a certain weapon, an indication is axiomatically set by the system to allow the program to recognize the player is using a certain weapon, wherein the program will be able to adapt the game to reflect the addition of the weapon, as is notoriously well known in the art.

Regarding claim 6, 19 and 32, parameters of the second object are changed based upon the changing of the second object as it is disclosed that action of the second characters is taken in accordance with inputs relating to the first character, thus axiomatically changing parameters of the second character based upon related parameters to the first character (Column 5, lines 1-10).

Regarding claim 7, 20 and 33, Horigami et al. discloses that the second object does not have to be generated (Column 6, lines 51-52) and discloses a number of circumferential conditions to determine the effects of characters on another (FIG 2). It would thus be obvious to one of ordinary skill in the art that if the ally character were not within a circumferential range to be of assistance to the first character, the program need not generate it as it would not be recognized as being on the battle field.

Regarding claims 8, 21 and 34, the second object is generated at a time predetermined by the gaming program in order to form an ally force with the first object (Column 5, lines 1-10; Column 10, lines 23-36). The characters are made in accordance with starting a battle (Column 11, lines 5-50).

Regarding claims 9, 22 and 35, the second object is generated at an instruction to start the battle predetermined by the gaming program in order to form an ally force with the first object (Column 5, lines 1-10; Column 10, lines 23-36). The characters are made in accordance with starting a battle (Column 11, lines 5-50).

Regarding claims 10, 23 and 36, the motion of the second object is controlled based upon indirect instruction from the act of the first player (Column 5, lines 1-10) or a predetermined definitive instruction operable by the first player (Column 10, lines 30-35).

Regarding claims 11, 24 and 37, a predetermined message is generated with the second object that details the strengths and power associated with the second object (FIG 2, reference 130).

Regarding claim 12, 25 and 38, Horigami et al. discloses that while the second character can take action in accordance with the first character, the second character can also be moved independently via control of the input device, thus it is self moving (Column 10, lines 30-35).

Regarding claims 13, 26 and 39, the first and second objects are personalized virtual characters in a three-dimensional space (FIG 2; Columns 10 and 11).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US Patent No. 6,540,606: Gaming device that allows a player to have the assistance of an ally in battle situations.

US Patent No. 6,375,572: Allows the incorporation of non-player characters that can serve to be allies to a player character.

US Patent No. 6,544,123: Player with a number of characters surrounding them wherein there are more than one character can be controlled by the player.

US Patent No. 6,159,100: Allows players to form ally groups in a virtual reality world wherein they can further battle together.

US Patent No. 6,540,614: Player is given more than one character to control in a video game wherein the player can exert control over the characters.

US Patent No. 6,290,604: Video game method for creating a shadow for a character wherein the shadow has an independent shape in comparison to the character.


US Patent No. 6,398,650: Gaming method that allows a group of characters to form allies among themselves.

US Patent No. 6,579,097: Gaming method that simulates a real life battle wherein an army has units shadowing each other to present an allied force.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.


cmm
August 25, 2003


Teresa Walberg
Supervisory Patent Examiner
Group 3700